

## REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated July 26, 2006.

Claims 10-17, 20-21 and 24-30 are pending in the instant application. In the most recent final Office Action, claims 20-24 are rejected under 35 U.S.C. §112, first paragraph for failing to comply with the written description requirement. Claims 10, 12-14, 16, 18 and 19-24 are rejected under 35 U.S.C. §102(b) as allegedly clearly anticipated by Avitall (U.S. Patent No. 5,555,883). Claims 11, 15 and 17 are rejected under 35 U.S.C. §103(a) as allegedly obvious over Avitall in view of any one of Ellis (U.S. Patent No. 6,093,185), Laufer (U.S. Patent No. 6,283,988), or Chia (U.S. Patent No. 5,897,554).

As amended above, claims 18-19 and 22-23 are canceled without disclaimer or prejudice to their subsequent reintroduction in this or a continuing application. New claims 25-30 are presented. Independent claim 25 is commensurate in scope with independent claim 10, while omitting the feature that the treatment section is for performing a high-frequency treatment. Claims 26-30 are commensurate in scope with claims 11-15, and depend from claim 25 in the same relationship as claims 11-15 depend from claim 10. Claims 25-30 are fully supported by the original specification as filed, and no new matter has been added.

At the outset, Applicant respectfully traverses the finality of this first Office Action following Request for Continued Examination, and requests that the finality be withdrawn. The MPEP states “[I]t would not be proper to make final a first Office Action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution, but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.” MPEP §706.07b. An Advisory Action was mailed 12 April 2006 in the instant application, denying entry of an Amendment to claim 16, citing new issues raised. That amendment to claim 16 was subsumed within the Amendment filed May 31, 2006. While the MPEP lacks the force of law, the public is entitled to rely upon it as a statement of USPTO procedure. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 7 U.S.P.Q.2d 1152 (Fed. Cir. 1988). Applicant respectfully submits that the finality of the most recent Office Action was premature and kindly requests that it be withdrawn.

Turning to the rejection of claims 20-24 under §112, first paragraph, as allegedly lacking written description in the specification, applicant respectfully traverses. Claims 23-24 are canceled, as noted above. The test for sufficient written description is not an *ipsis verbis* test. See, *Martin v. Johnson*, 454 F.2d 746, 172 U.S.P.Q. 391 (CCPA 1972); MPEP § 2163(II)(A)(3)(a). However, in order to avoid any potential for ambiguity, the phrase “returning force” has been deleted throughout the claims, and additionally, the adjective “naturally” as applied to titling has similarly been stricken. In place of “returning force”, the claims recite --an inherent elastically restoring force--. This phrase is supported throughout the specification as originally filed, for example at page 7, lines 7-11, among other places. No new matter has been added by these amendments, and Applicant respectfully submits that they obviate the rejection under §112, first paragraph. Favorable reconsideration and withdrawal of the rejection is kindly requested.

Turning then to the application of the references to claims 10-24 and particularly the Office Actions Response to Arguments, as amended above each independent claim recites an inherent elastically restoring force with reference to either an elastic deformable portion, as in independent claims 10, 16, 19 and 24, or simply a deformable portion, with reference to claim 18. The Office Action reads the Avitall reference and particularly, the control wires 124, 126 to read on the previously recited returning force. However, any force **provided by control wires** 124 and 126 (emphasis supplied in Office Action, p. 5) is provided or applied. It is not inherent, as recited in the independent claims. Therefore, Applicant respectfully submits that the claims are patentably distinguished over Avitall, and kindly requests favorable reconsideration and withdrawal of the rejection. Each of dependent claims 11-15, 17 and 20-23 depend from either directly or indirectly from one of independent claims 11, 16, 18 or 19. These dependent claims are each separately patentable but are offered as patentable for at least the same reasons as their underlying base claims. Favorable reconsideration and withdrawal of the rejection with respect to the dependent claims is kindly solicited.

Turning to the rejection of claims 11, 15 and 17 as allegedly obvious over Avitall over Ellis, Laufer or Chia, applicant respectfully traverses. Precisely this sort of broad brush alternative form of rejection was held not to establish a *prima facie* case of obviousness. *Ex*

*parte Blanc*, 13 U.S.P.Q. 2d 1383 (BPAI 1989). Moreover, the Office Action fails to set forth exactly what teachings of either Ellis, Laufer or Chia one of ordinary skill in the art would apply in combination with Avitall to achieve the claimed invention. Rather, the Office Action merely states that it would have been obvious to modify Avitall to determine optimal dimensions through routine experimentation. It is not at all clear that Ellis, Laufer or Chia are relied upon in any fashion.

Further, the Office Action fails to set forth any teaching, suggestion or motivation for one of ordinary skill in the art at the time the invention was made to modify Avitall in the manner proposed. The absence of a suggestion or motivation to combine is dispositive in an obviousness determination *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence. *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 63 U.S.P. Q. 2d 1374 (Fed. Cir. 2002). In light of the complete absence of any teaching, suggestion or motivation to combine the references as proposed in the Office Action, applicant respectfully submits that the rejection is poorly taken, and kindly requests favorable reconsideration and withdrawal.

However, in the interest of advancing prosecution, and without prejudice to the foregoing, independent claims 10 and 16 as amended above and new claim 25 each recite the loop plane including the loop central axis is substantially parallel to the moving axis of the actuating member, and further that the loop axis connecting the distal and proximal ends of the loop is tilted against the moving axis. These features are supported in the original specification, for example at Figs. 2A, 2B, among other places.

In contrast to the independent claims, in the loop of Avitall (see, Figs. 2, 7A) a loop axis connecting the proximal and distal ends of the loop is generally parallel with the moving axis of an actuating member. Therefore, Applicant respectfully submits that independent claims 10, 16 and 25 are further distinguished over Avitall, alone or in combination with any of Ellis, Laufer or Chia.

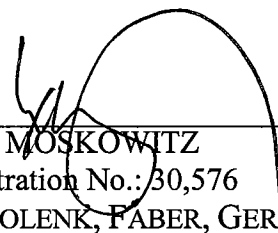
In light of the foregoing, Applicant respectfully submits that all claims are patentable and in condition for allowance. In the interest of brevity, Applicant has addressed only so much

of the rejections as is considered sufficient to demonstrate the patentability of the claims. Applicant's failure to address any portion of the rejections should not be construed as an acquiescence in the propriety of such portions not addressed. Applicant maintains that the claims are patentable for reasons other than those specifically discussed, *supra*.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue. If the Examiner has any reservation in allowing the claims, and believes that a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully submitted,

THIS CORRESPONDENCE IS BEING  
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